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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,698	11/27/2001	William B.S. Pressly Sr.	14112-187003	2662

7590 11/03/2004
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EXAMINER

DESANTO, MATTHEW F

ART UNIT PAPER NUMBER

3763

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,698

Applicant(s)

PRESSLY SR. ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The 112 rejections are withdrawn because of the amendments and the remarks made by the applicant.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Caselli (USPN 5,201,710).

Caselli discloses an interchangeable needle (19), an elongated barrel, a movable base (12), a spring (21) and at least one support member (24). (Figures 3-9 and entire reference)

4. Claims 1-11, 13, 15, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pressly, Sr. et al. (USPN 5,613,952).

Pressly, Sr. et al. discloses an interchangeable needle, an elongated barrel, a movable base (11), a spring and at least one support member (31), as well as a retainer catches, and an integral sacrificial seal on the base. (Figures 1-26 and entire reference)

Pressly, Sr. et al. also discloses a method of operating of the syringe as well as a method of producing the product. (Figures 1-26 and entire reference)

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Caralt Batlle (USPN 5,114,410).

Caralt Batlle discloses an interchangeable needle, an elongated barrel, a movable base (11), a spring and at least one support member (31). (Figures 1-26 and entire reference)

Allowable Subject Matter

6. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

The applicant argues several points with regards to the prior art.

The first point is the term "interchangeable." The examiner interprets this language as broadly as possible, and therefore interprets "interchangeable" to mean a needle that can be changed. This can be done prior to manufacturing or after injecting the fluid. There is no other function or structural limitation with regards to this element. The examiner agrees that the term interchangeable as described in the specification has a different function and comprises more elements such as a threaded needle head that mates with the threaded portion of the needle hub, but this is not claimed.

Therefore the examiner must interpret this language in accordance with MPEP section 2114.

With regards to Caselli, the applicant argues limitations not in the claim, by stating the moveable base is adapted for maintaining the needle hub, but on the contrary the language in the claim reads a "movable base adapted to releasably constrain a needle hub", which is what the movable base does in Figure 8.

The examiner also disagrees with the interpretation of Pressly, Sr, et al. not disclosing a moveable base with a support member that surrounds a portion of the spring. This can be seen in figures 2, 23-26, 30, 41, 42, 43, and 45.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

The examiner can be reached Monday-Friday 9:30-6:00 at 1-703-305-3292.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (703) 308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



NICHOLAS D. LUCCHESI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3

Art. Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
November 1, 2004